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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,520	09/25/2003	Per Ehrenreich Nygaard	1175/71019	1183
7590 Donald S. Dowden Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036				
EXAMINER				
HALL, DEANNA K				
ART UNIT		PAPER NUMBER		
3767				
MAIL DATE		DELIVERY MODE		
08/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/672,520

**Applicant(s)**

NYGAARD ET AL.

**Examiner**

DEANNA K. HALL

**Art Unit**

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 13, 2009 (6/05/09).  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 7, 9 and 10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-2, 4-5, 7, 9-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2009 has been entered.

### ***Acknowledgments***

2. This office action is in response to the reply filed on June 5, 2009.
3. In the reply, the applicant amended claims 1, 2, 4, 5, 7 and 9.
4. Claims 1-2, 4-5, 7 and 9-10 are pending in the application.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-2, 4-5, 7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabiner et al. (US 6,524,251) ("Rabiner") in view of Dietz et al. (US 5,931,787) ("Dietz") further in view of Francis (US 5,954,637).**

Rabiner discloses a catheter with at least two circular or partially circular cross sectional parts 109, 109, Fig. 3F where a rod 6 is inserted between the parts and at the end is provided with an ultrasonic transducer 22, 23. The semi-circular parts are surrounded by an outer tube 108, Fig. 3B. Further, Rabiner discloses that the parts 109, 109 can be locked relative to one another 113 and that the rod 6 with the ultrasonic transducer can be rotated relative to the completely or partially circular parts C4 L54-56. The surface of at least one of the parts 109 is provided with a longitudinal groove for the insertion of a surgical instrument col. 9 lines 6-11, C10 L12-14. A longitudinal groove 60 for the insertion of a surgical instrument, a flexible needle, 30 is also taught by Dietz, see Fig. 3. Dietz further teaches that the groove ends below the outer tube and is shaped such that the flexible needle extends behind the outer tube. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Rabiner with the groove outside the catheter part for the insertion of a flexible needle as taught by Dietz for aspirating or extracting tissue samples.

7. With reference to claims 1, 9 and 10, Rabiner in view of Dietz discloses the invention as substantially claimed (see above). However, this combination does not directly disclose the circular or partially circular cross sectional parts 109, 109 being removably engageable with one another and capable of being removed from the outer

tube and disengaged from each other for sterilization/disinfecting purposes. Francis, in the analogous art, teaches two housing pieces 110a, 110b removably engageable and locked relative to one another, Fig. 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the connection 113 removably engageable for easier disinfecting or sterilization. Here, in Dietz, an object of the invention is to provide a reusable sheath 12 which can be readily sterilized C2 L64-65. Thus, since it is considered desirable to remove and sterilize the sheath it would be obvious to make the two parts 109, 109 removably engageable with one another as taught by Francis to allow for easier removal around the probe and other parts of the ultrasonic device. Thus also, once the parts were separate, it would be inherent that the outer tube 108 surrounding the parts would keep together the parts. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 9:00am-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deanna K. Hall/  
Examiner, Art Unit 3767  
7/24/09  
/Kevin C. Simons/  
Supervisory Patent Examiner, Art Unit 3767